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EXAMINER

KASHNIKOW, ERIK

ART UNIT

PAPER NUMBER

1782

NOTIFICATION DATE

DELIVERY MODE

07/29/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/560,033 | Applicant(s) WAKAI ET AL. | |
| | Examiner ERIK KASHNIKOW | Art Unit 1782 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 7 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 11/596,678 in view of Ikeda et al. (US 6,214,476). Although the conflicting claims are not identical, they are not patentably distinct from each other the difference in the range of linear low density polyethylene. The present claims require 45-5% whereas the copending claims claim 45-10%, which leaves a difference of 5% on the lower end of the scale, however it would have been obvious to one of ordinary skill in the art that the amount of linear low density polyethylene disclosed in the copending claim falls

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completely within the broad range presently claimed and thus one of ordinary skill in the art would have arrived at the present invention. It is further pointed out that labels are designed to go on containers, so it would have been obvious to one of ordinary skill in the art to attach said label to a container. Further Ikeda et al. teach that petroleum resin acts as a tackifier when mixed in with polyolefin resins (column 6 lines 48-54). Ikeda et al. teach that the tackifier is present in amounts from 50-99% by weight of the olefin (column 4 lines 40-55). As all components of the instant invention are present and within the ranges claimed, the lateral direction shrinkage of the invention of Ikeda and the copending claims would intrinsically be the same. One of ordinary skill in the art at the time of the invention would be motivated to add the tackifier because it results in increased adhesion between layers (column 1 lines 7-16). It is noted that the copending invention teaches that the overcoat layer is for improved abrasion resistance, and therefore it would be obvious to one of ordinary skill in the art to eliminate the overcoat layers at the position of overlapping as the abrasion resistance would not be required as it would be provided by the upper layer (MPEP 2144.04) II.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claim 7 directed to an invention not patentably distinct from claim 1 and 2 of commonly assigned 11/596,678. Specifically, although the conflicting claims are not identical they are not patentably distinct for the reasons set forth in paragraph 3 above.
4. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP

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Chapter 2300). Commonly assigned 11/596,678, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satani et al. (US 2002/0192412), Ishige et al. (US 2002/0155277) in view of Arjunan et al. (WO 98/44043), Ikeda et al. (US 6,214,476) and Hoffman (US 4,416,714).

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7. In regards to claim 1 Satani et al. teach polyethylene terephthalate (hereinafter PET) bottles with heat shrunk labels attached thereon (paragraph 0001) Satani et al. teach a multilayered stretched resin film with excellent printability that can be used as a label (paragraph 0001). Satani et al. teach that the outer label may be comprised of cycloolefins and mixed with a polyethylene (paragraph 0032). Satani et al. further teach that the intermediate layer maybe comprised of polyethylene (paragraph 0022). It is noted that Satani et al. teach other layers may be added, but are silent with regards to specific formations.

8. As disclosed above Satani et al. teach a PET container with a heat shrunk label comprising 3 layers, however they are silent with regards to the use of polypropylene as the inner layer.

9. In regards to claim 7 Ishige et al. teach multi layer films that may be used as labels with at least 2 different layers, Layer A, a base layer, which contains 40-90% a polyolefinic resin and 10-60% an organic filler (corresponding to applicants intermediate film layer), and layer B containing 0-85% a polyolefinic resin and 15-100% of an amorphous resin (corresponding to applicants front-back film layers). It is noted that films inherently have at least 2 edge portions. Ishige et al. also teach an optional surface layer, Layer C (paragraph 0019). In regards to layer A Ishige et al. teach that the polyolefinic resin maybe a polypropylene alpha olefin copolymer resin, and specifically an ethylene propylene random copolymer (paragraph 0023). Further Ishige teaches that it is known in the art that the polypropylene copolymers and the polyethylene copolymers are known equivalents as intermediate layers in labels

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(paragraph 0023), as such it would be obvious to one of ordinary skill in the art at the time of the invention to use the polypropylene resin of Ishige in place of the polyethylene resin of Satani et al. Ishige et al. further teach that the organic filler can be cyclopolyolefins (paragraph 0027). In regards to layer B Ishige et al. teach that the polyolefinic resins for layer B follow the same limitations of the polyolefinic resin in layer A (paragraph 0034), which includes polyethylene with densities between 0.89-0.97g/cm³ which encompasses the range of linear low density polyethylene's (LLDPE). Ishige et al. further teach that the amorphous resin is typically exemplified as a cycloolefinic resin (paragraph 0036). Ishige et al. teach that typical film embodiments will have layers sequenced C/B/A/B (paragraph 0060). In regards to the haze as all the materials are the same and present in the concentration ranges claimed, the film must necessarily have the same haze range. It is also noted that haze is defined as the difference between gloss at 60 and 200, where as opacity is the degree to which a coating will obstruct the surface it has been applied to (<http://www.bamr.co.za/appearance.shtml>). Examiner points out that an article may be glossy and opaque. Further it is noted that Ishige et al. teach that the film preferably has an opacity of 70% and higher so that a paper like texture is obtained. It is noted that it is obvious to eliminate a step or element and its function (paragraph 0059). As the instant application does not require a paper like texture it would be obvious to lower the opacity since the property on which opacity is depend upon for is not desired (MPEP 2144.04 II A).

10. In regards to claim 8 Ishige et al. teach that another layer sequence for their film can be C/B/A/B/C (paragraph 0079).

11. One of ordinary skill in the art at the time of the rejection would be motivated to modify the invention of Satani et al. with that of Ishige because the invention of Ishige offers improved printing properties including excellent ink drying property, and less causative waving or entire curling of the film due to printing procedures (paragraph 0009).

12. While Satani et al. and Ishige et al. teach the composition and the layer sequence of the film they are silent about specifically using LLDPE.

13. Arjunan et al. teach LLDPE resins which are improved in their ability to be formed into a film layer (page 3 lines 19-20).

14. In regards to claim 7 Arjunan et al teach that LLDPE is desirable as a resin for films because of its relatively low cost compared to other resin types and its excellent mechanical, physical and chemical properties (page 2 lines 25-30).

15. In regards to claim 9 Arjunan et al. teach that the LLDPE can be one which is produced with metallocene based catalyst systems (page 6 lines 14-19).

16. In regards to claim 7 the physical/mechanical properties of claim 1 while Ishige et al. and Arjunan et al. are silent regarding the properties claimed by applicant, Ishige et al. and Arjunan et al. teach all the materials and limitations of applicant and the physical properties are therefore considered inherent.

17. In regards to claims 10 Examiner points out that the claims will be treated as product by process claims (MPEP 2113) specifically the portion of the claim that is

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treated in this manner is “the label being heat shrunk onto the container body”. Ishige et al. teach that the films of their invention are useful as labels (paragraph 0001). It is obvious to one of ordinary skill in the art at the time of the invention that labels are placed onto containers.

18. One of ordinary skill in the art at the time of the invention would be motivated to modify the films of Satani et al. and Ishige et al. with that of Arjunan et al. because the films of Ishige et al. which offers improved drying properties and is excellent in printing property (paragraph 0009 and 0010), would benefit from the low cost and excellent mechanical/physical/chemical properties of Arjunan et al. (page 2 25-30).

19. As stated above Satani Ishige et al. and Arjunan et al. teach a heat shrink film used as a label which comprises a cyclic polyolefin and LLDPE that would intrinsically have the same shrinkage in the lateral direction as well as the same mechanical physical and chemical properties, however they are silent regarding forming a tube of the film before and attaching said tube of film as a label.

20. In regards to claims 7 and 10 Hoffman teaches methods for attaching heat shrink labels (column 1 lines 15-20).

21. Hoffman teaches that a method for attaching heat shrink labels to containers consists of taking a film and forming a tube wherein the leading edge of the tube overlaps with the trailing edge of the tube, and then heat shrinking the label to the container (column 1 lines 58-64). It is noted that this method is that used to describe a center seal in the instant application.

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22. In regards to the limitation in claim 7 regarding the overcoat layer being over the entire base layer with exception of the area of overlap, Ishige et al. teach that the overcoat/outer layer is present so that an improved ink drying property and overall printing property is present (paragraph 0010). It has been held that an elimination of an element and its function is non obvious if the element and its function is not desired (MPEP 2144.04 II). It would be obvious to one of ordinary skill in the art at the time of the invention to not include the overcoat/outer layer in the overlap area of the center seal because that area would be covered by the other portion and there would be no printing therein, and as such no need for the over coat layer. This would also have an economical benefit as it would save on costs by using less material.

23. One of ordinary skill in the art at the time of the invention would be motivated to modify the invention of Satani et al, Ishige et al. and Arjunan et al. with that of Hoffman because the invention of Hoffman offers saves material and energy, and therefore saves money (column 6 lines 60-67).

Response to Arguments

24. It is noted that the double patenting rejection will be held in abeyance.

25. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. It is noted that no new art has been used however the previous prior art has been used to reject the new limitations.

26. It is noted that while Ishige, Arjunan and Hoffman do not disclose all the features of the present claimed invention, they are used as teaching reference, and therefore, it

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is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, and in combination with the primary reference, discloses the presently claimed invention. If the secondary reference contained all the features of the present claimed invention, it would be identical to the present claimed invention, and there would be no need for secondary references.

Conclusion

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erik Kashnikow whose telephone number is (571)270-3475. The examiner can normally be reached on Monday-Friday 7:30-5:00PM EST (Second Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Erik Kashnikow
Examiner
Art Unit 1782

/Rena L. Dye/
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